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EXAMINER

PYZOCHA, MICHAEL J

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2137

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Please find below and/or attached an Office communication concerning this application or proceeding.

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Technology Center 2100

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/029,960
Filing Date: December 21, 2001
Appellant(s): SIMPSON ET AL.

David R. Risley
(Reg. No. 39,345)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 09/05/2007
appealing from the Office action mailed 12/05/2005.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

NEW GROUND(S) OF REJECTION

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Claims 21-23 are rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6601172	EPSTEIN	7-2003
6298446	SCHREIBER et al.	10-2001
6957347	BRAAM et al.	10-2005
6611599	NATARAJAN	08-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

Claims 1, 5-13, 17-23, 29-31 are rejected under 35 U.S.C. 102(e) as being anticipated by Epstein (US 6601172).

As per claims 1, 13 and 21, Epstein discloses retrieving imaging data on behalf of a user via a network from the user's personal imaging repository with a network-based notarization service via an imaging extension; and electronically notarizing the imaging data with the network-based notarization service (see column 4 lines 20-22 and column 5 lines 15-47).

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As per claims 5 and 17, discloses the imaging extension comprises part of a user browser (see column 5 lines 15-47).

As per claims 6 and 18, Epstein discloses the imaging extension comprises part of the network-based notarization service (see column 5 lines 15-47).

As per claims 7, 19 and 22, Epstein discloses the step of electronically notarizing imaging data comprises modifying the imaging data by adding at least one of a stamp and a digital signature to the imaging data (see column 4 lines 20-22).

As per claims 8-9, Epstein discloses storing the modified imaging data in a user personal imaging repository (see column 4 lines 20-22).

As per claims 10, 20 and 23, Epstein discloses the step of electronically notarizing imaging data comprises generating a notarized certificate (see column 4 lines 45-48).

As per claims 11-12, Epstein discloses storing the certificate in a user personal imaging repository (see column 4 lines 55-57).

As per claims 29-30, Epstein discloses the digital signature comprises the identity of the network-based notarization service that notarized the imaging data and the date the notarization occurred (see column 8 lines 50-52).

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As per claim 31, Epstein discloses the notarization is internally stored by the network-based notarization service that performed the notarization (see column 4 lines 50-51).

Claim Rejections - 35 USC § 103

Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein as applied to claims 1 and 5 above, in view of Schreiber et al (US 6298446).

As per claims 24-25, Epstein fails to disclose the imaging extension comprises an API and the browser uses generic commands.

However, Schreiber et al teaches such methods (see column 18 lines 19-38).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Schreiber et al's API in the system of Epstein.

Motivation to do so would have been to deal with protected images (see column 18 lines 19-38).

Claims 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein as applied to claim 6 above, in view of Braam et al (US 6957347).

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As per claims 26-27, Epstein fails to disclose using a redirect address for authentication.

However, Braam et al teaches such redirection (see column 6 lines 15-27).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use redirection in the system of Epstein.

Motivation to do so would have been to prevent users from accessing unauthorized databases (see column 6 lines 15-27).

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Epstein as applied to claim 7 above, in view of Natarajan (US 6611599).

As per claim 28, Epstein fails to disclose the stamp comprises a watermark.

However, Natarajan teaches a watermark (see column 5 lines 15-44).

At the time of the invention it would have been obvious to a person of ordinary skill in the art for Epstein's stamp to be a watermark.

Motivation to do so would have been that it is impossible to remove a watermark (see column 5 lines 15-44).

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 101

Claims 21-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims lack the necessary physical articles or objects to constitute a machine or a manufacture within the mean of 35 USC §101. They are clearly not a series of steps or acts to be a process not are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*. These claims recite that logic is stored on a computer-readable medium, which is defined on page 18 of the specification to include any means to store, communicate, propagate, or transport its contents such as an electrical connection. Claims 21-23 are non-statutory because the definition of "computer-readable medium" includes non-statutory subject matter.

(10) Response to Argument

A. Claim Rejections - 35 USC 102(e)

1. The Epstein Disclosure

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Appellant cites portions of columns 2 and 3 in an attempt to show that Epstein fails to disclose retrieving image data to be notarized because the image data is not notarized. However, these cited portions relate to a first embodiment, not relied upon by the Examiner, of Epstein. The portion of Epstein, which anticipates Appellant's claimed invention, is described in columns 4 and 5 referring to figures 2a through 2d. Specifically, the image is notarized in column 4 line 58 through column 5 line 14 and retrieved in column 5 lines 15-21. Therefore, Epstein does retrieve notarized image data.

2. Applicant's Claims

a. Claims 1, 5-12, and 29-31

(i) Network-Based Notarization Service "Retrieving Imaging Data on Behalf of a User"

Appellant argues that Epstein does not teach a "network-based notarization service" "retrieving imaging data on behalf of a user". With respect to this argument Epstein teaches the notarization of imaging data using a server and a notary service, both of which are connected to a network, in column 4 line 58 through column 5 line 14. Therefore, Epstein discloses a "network-based notarization service". Furthermore, as an additional piece to this network-based notarization service, Epstein discloses a viewer for viewing the notarized images.

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Specifically in column 5 lines 15-17, "a user requests the image for viewing on a viewer and the stored image is provided" and further describes in column 5 lines 22-29 that the image is from the server that is part of the network-based notarization service. Since the server, notary service and viewer are all part of the system for providing notarized imaging data over a network, Epstein discloses a "network-based notarization service" "retrieving imaging data on behalf of a user".

(ii) "From the User's Personal Imaging Repository"

Appellant argues that Epstein fails to disclose retrieving imaging data from the user's personal imaging repository. With respect to this argument, column 5 lines 15-17 discloses retrieving data for a user and column 5 lines 22-29 teach that this image data is retrieved from the server (see additionally column 4 lines 55-57 where the server stores the information). This server is "the user's personal imaging repository" since it stores all of the imaging data for each user.

(iii) "Retrieving...Via an Imaging Extension"

Appellant argues that Epstein fails to retrieve the imaging data via an imaging extension. Appellant further describes that the specification defines an "imaging extension" as a component that is called upon to act as a gateway to access the user's personal imaging repository. In response to this argument, in column 5

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lines 15-22, "a user requests the image for viewing on a viewer and the stored image is provided" also "the user requests the image using the viewer". This viewer retrieves the image data from the server and displays the images for the user (see column 5 lines 19-47). The viewer acts as a gateway to access the user's personal imaging repository and is therefore an "imaging extension".

(iv) "Notarizing the Imaging Data"

Appellant argues that Epstein does not teach, "electronically notarizing the imaging data". As stated above, the image is notarized in column 4 line 58 through column 5 line 14.

Additionally, the purpose of the Epstein patent is to notarize documents, "In the invention disclosed herein an original document and a revised document are notarized" (see column 1 lines 50-51). In the cited portion of columns 4 and 5 the document is the image. Therefore, Epstein clearly discloses, "electronically notarizing the imaging data".

(v) Dependent Claims

Appellant argues that Epstein fails to disclose the imaging extension comprises "part of a user browser" as in claim 5. As explained above, the view itself is an imaging extension. Furthermore, the viewer is also a browser. Giving "browser" its broadest reasonable interpretation it is "2. Computer Science. A

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program that accesses and displays files and other data available on the Internet and other networks" (taken from Answers.com). Therefore, as described above, since the viewer accesses and displays the images requested by the user it is a browser.

Appellant argues that Epstein fails to disclose the imaging extension comprises "part of the network-based notarization service" as in claim 6. As explained above, the server, notary service and viewer are all part of the system for providing notarized imaging data over a network. Therefore, the viewer is a "part of the network-based notarization service".

Appellant argues that Epstein fails to disclose that notarizing comprises "modifying the imaging data by adding at least one of a stamp and a digital signature to the imaging data" as in claim 7. However, "the server combines the condensation hash and the notary's image signature...by appending the image signature to the image". Therefore, the notarization appends a digital signature to the imaging data, thereby modifying the imaging data as claimed.

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Appellant argues that Epstein since fails to disclose modifying the imaging data it cannot store the imaging data as in claim 8. However, as shown above Epstein does modify and store the imaging data (see column 5 lines 1-7).

Appellant argues that Epstein fails to disclose storing the modified imaging data in a "personal imaging repository" as in claim 9. However, as stated above the server is the "personal imaging repository" and this is where the modified imaging data is stored (see column 5 lines 3-7).

Appellant argues that Epstein fails to disclose a "notarization certificate" as in claims 10-12. Appellant's specification describes this certificate as "a notarization certificate can be generated that contains the various information concerning the notarization". Therefore, the information appended to the image data, described in column 5 lines 1-7, is the "notarization certificate".

Appellant argues that Epstein fails to disclose the notarization is internally stored by the network-based notarization service that performed the notarization, as in claim 31, because the host notary system does not store anything. With respect to

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this argument, in the more detailed description of the notary it states that the notary "copies the time stamp and time stamp signature through IOC 455 onto the hard disk drive 456." Therefore, the host notary stores the notarization information internally.

b. Claims 13 and 17-20

Appellant argues that Epstein does not disclose the limitations of claims 13 and 17-20. Each of these limitations has been addressed in the above response with respect to claims 1, 5-7 and 10. These arguments have been fully addressed above.

c. Claims 21-23

Appellant argues that Epstein does not disclose the limitations of claims 21-23. Each of these limitations has been addressed in the above response with respect to claims 1, 7 and 10. These arguments have been fully addressed above.

B. Claim Rejections - 35 USC 103(a)

1. Rejection of claims 24 and 25

Appellant's argument that Schreiber does not remedy the deficiencies of Epstein is moot in view of the above response.

Appellant argues there is no motivation to modify the viewer of Epstein to comprise an API. However, Schreiber teaches a method

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of using an API to handle protected images. The motivation to include the API of the viewer in Schreiber in the viewer of Epstein would have been to handle protected images. Therefore, there is proper motivation to modify the viewer of Epstein to comprise the API of Schreiber.

Appellant argues that Schreiber's APIs are not imaging extensions that perform the retrieving of imaging data. This is not claimed. Claim 24 merely states, "the imaging extension comprises application programming instructions". Since the imaging extension is required to comprise APIs, when the Schreiber viewer APIs are combined with the viewer of Epstein, the combination discloses an imaging extension that includes (i.e. comprises) APIs.

Appellant argues that Schreiber does not disclose any "generic access instructions". However, Schreiber teaches the well-known technique of accepting a generic command to access information (i.e. copying) and performing a most specific task (i.e. apply special logic such as adding a watermark). Therefore, it would have been obvious to one of ordinary skill in the art to use these types of generic commands to access the personal image repository of Epstein.

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2. Rejection of Claims 26 and 27

Appellant's argument that Braam does not remedy the deficiencies of Epstein has been fully addressed above.

Appellant argues that there is no motivation to determine the location of the imaging repository or to perform authentication because Epstein does not use a browser to view the images or contemplate any authentication. However, as described above, Epstein does provide a browser. Additionally, Epstein uses digital signatures to authenticate the origin of data.

Therefore, there are reasons to combine. The Braam reference additionally provides the motivation to combine the references as preventing users from accessing unauthorized databases.

Therefore, there is motivation to combine the references.

3. Rejection of Claim 28

Appellant's argument that Natarajan does not remedy the deficiencies of Epstein has been fully addressed above.

Appellant argues that there is no modifying of imaging data and therefore no motivation to place a watermark on the image.

However, as explained above, Epstein discloses modifying the image data. Therefore, it would have been obvious to one of

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ordinary skill in the art for the stamp to comprise a watermark because the watermark of Natarajan is impossible to remove (see column 5 lines 38-44).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

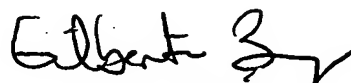
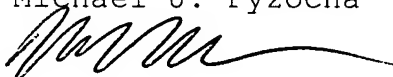
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(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,

Michael J. Pyzocha



GILBERTO BARRON JR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:



JAMES DWYER, DIRECTOR
TECHNOLOGY CENTER 2100

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Conferees:

Gilberto Barron

A handwritten signature in black ink, appearing to read 'GB' followed by a stylized flourish.

/Benjamin Lanier/

Benjamin Lanier

Examiner Art Unit 2132